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**THIS DISPOSITION  
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Paper No. 21

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re U.S. Tsubaki, Inc.

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Serial No. 75/103,066

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James C. Wray for U.S. Tsubaki, Inc.

Jan A. Holland-Chatman, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

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Before Quinn, Wendel and Bucher, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

U.S. Tsubaki, Inc. has filed an application to  
register the mark G.I.S. for "consultation services,  
namely, providing geographic information systems for  
assisting distributors in locating and identifying  
potential customers for chains and sprockets."<sup>1</sup>

Registration of the mark has been finally refused  
under Section 2(e)(1) of the Trademark Act on the ground

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<sup>1</sup> Serial No. 75/103,066, filed May 13, 1996, based on an  
allegation of a bona fide intention to use the mark in commerce.

that the mark, if used in connection with the recited services, would be merely descriptive thereof. The requirement for an acceptable identification of services has also been made final. The refusals have been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Identification of Services Requirement

Before considering this requirement, a brief review of the prosecution history in is order.

In the initial Office action, the Examining Attorney objected to the recitation of services, as set out above, as indefinite and requested amendment to "consultation services relating to geographic information systems for assisting distributors in locating and identifying potential customers for chains and sprockets." Applicant responded by amending the services to "assisting distributors of chains and sprockets in identifying potential customers." The Examining Attorney made no specific reference to this amended identification of services in the following Office action; he simply made the requirement for an acceptable identification final, as well as the pending Section 2(e)(1) refusal.

Applicant then filed a response in the nature of a request for reconsideration and amended the identification

of services to "consultation services for assisting distributors of chains and sprockets in locating and identifying potential customers for chains and sprockets." At this point, a new Examining Attorney was assigned to the case who issued a continuation of the Section 2(e)(1) final refusal, but made no mention of the identification of services requirement. In view of applicant's apparent failure to timely file a notice of appeal the application was concurrently held abandoned.

Upon review by the Board, it was determined that a notice of appeal had been timely filed, as well as an appeal brief, and the case was forwarded to the Examining Attorney for preparation of a brief. The Examining Attorney then filed a request for remand in order to supplement the record of the prior Examining Attorney and to more fully address the issue of applicant's amended identification of services. The request was granted and, on remand, the Examining Attorney issued two further actions finding applicant's proposed amendment of services unacceptable and subsequently making the requirement for an acceptable recitation final. The Section 2(e)(1) refusal was again made final. The appeal was then resumed and applicant allowed time to file a supplemental brief.

Applicant, in its brief, contends that the identification of services now reads:

Consultation services for assisting distributors of chain and sprockets in locating and identifying potential customers for chains and sprockets.

The Examining Attorney maintains that this proposed recitation of services is unacceptable in that it exceeds the scope of the identification in the application as filed. By deleting the language "providing geographic information systems," the Examining Attorney argues, applicant has attempted to eliminate a specific feature of its services and thus broaden the characteristics of its consultation services.

Applicant, on the other hand, insists that the Trademark Rules and the TMEP, specifically §804.09(a), encourage deletion and thus the proposed amendment is acceptable. Applicant also argues that the issue of the amendment exceeding the scope of the original identification should be withdrawn, not having been raised until the third Office action following the amendment.

We would first point out that the initial final refusal was in effect withdrawn when the case was remanded to the Examining Attorney and a new non-final action was issued with respect to the proposed amendment of the identification of services. Applicant was given full

opportunity to respond to the requirement for an acceptable identification before the requirement was made final in the second action. Applicant's request that the requirement be withdrawn is without merit.

Looking to the requirement on the merits, we are guided by the language of the controlling rule, Trademark Rule 2.71 (a):

The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.

We are in complete agreement with the Examining Attorney that by applicant's proposed elimination of the means by which its consultation services are performed, i.e., geographic information systems, applicant would be broadening the scope of its consultation services. This is clearly impermissible under Rule 2.71(a).

While TMEP § 804.09(a) refers to deletion as one way of limiting an identification of goods or services, deletion is defined as the "elimination of an existing item in an identification of goods and services in its entirety." As pointed out by the Examining Attorney, applicant has not eliminated a particular item listed in its identification in its entirety; applicant has simply eliminated qualifying language with respect to the nature of its consulting services. The resultant effect is a

broadening of the scope of the services, not a limiting thereof. The proposed amendment is unacceptable. For purposes of the Section 2(e)(1) refusal, we consider the identification of services to stand as originally set forth in the application.<sup>2</sup>

Section 2(e)(1) Refusal

The Examining Attorney has refused registration under Section 2(e)(1) on the basis that the proposed mark G.I.S., when used in connection with applicant's services, would be merely descriptive of a feature or characteristic of the services. She argues that G.I.S. is a widely used initialism<sup>3</sup> for the term "geographic information systems" and that when used in connection with applicant's services G.I.S. merely imparts information as to the type of system which applicant employs to perform its potential customer identification services.

As support for her position that the term GIS is a recognized initialism for "geographic information systems" the Examining Attorney refers to the *Acronyms, Initialisms*

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<sup>2</sup> We note that applicant has made no argument with respect to the acceptability of the original identification. Thus, we assume that applicant has acquiesced in the requirement that this original identification must be reworded.

<sup>3</sup> While the Examining Attorney has referred to G.I.S. as an acronym, we find the more accurate manner in which to refer to the term is as an "initialism."

& *Abbreviations Dictionary* (1987);<sup>4</sup> various third-party registrations containing the language "geographic information systems" in the identifications and disclaimers of the "GIS" portion of the marks; and numerous excerpts of articles from the NEXIS database showing the cross-reference of the term "geographic information systems" with the letters GIS. In addition the Examining Attorney points out that applicant has attached information to its appeal brief showing similar usage of GIS by the United States Geological Survey of the initialism GIS in reference to "geographic information systems."<sup>5</sup>

As a general rule, acronyms or initialisms of descriptive words are only considered descriptive themselves when they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith. See *Avtex Fibers Inc. v. Gentex Corp.*, 223 USPQ 625 (TTAB 1984) and the cases cited therein. Here we find the evidence overwhelming that GIS is a widely accepted initialism for the term "geographic information systems." Moreover, although

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<sup>4</sup> The dictionary entry shows GIS to be an initialism for "geographic information systems" as used by the United States Geological Survey.

<sup>5</sup> Inasmuch as the Examining Attorney has made full reference and use of the materials attached to applicant's brief, we consider the attachments to be of record.

applicant argues that its mark is used with periods to separate the letters and that this is simply an arbitrary arrangement of letters, we do not agree. We find the commercial impression and the information imparted thereby to remain the same, as the initialism GIS.

The only remaining issue is whether this initialism has descriptive significance when used in connection with applicant's consulting services. A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used, or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, or is intended to be used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in



order to be merely descriptive; it is sufficient if the term or phrase describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Applicant insists that its services involve assisting distributors of chains and sprockets in identifying customers; and that these consultation services do not involve the use of geographic information services as referenced by the United States Geological Survey.

As pointed out by the Examining Attorney, applicant's own identification of its services refutes this argument. Furthermore, regardless of the particular focus of applicant's consulting services, the question here is the means used to perform these services. The identification specifically sets forth that these consulting services employ "geographic information systems" as the means for providing the desired information.

Applicant argues that the term GIS as referenced by the United States Geological Survey is typically used in connection with generating maps displaying data about varying geographic features. Citing the attachments to its brief, applicant argues that these maps are used primarily for government, town planning, public utility management and environmental management.

Looking to the information attached to applicant's brief, we find further disclosure with respect to the nature and usages of geographic information systems. From that which appears to be a Webpage of the U.S. Geological Survey, we note the following general definition of a "GIS":

...a GIS is a computer system capable of assembling, storing, manipulating, and displaying geographically referenced information, i.e., data identified according to their locations.

In the attachment from the source identified as "AGI" we find that the uses of GIS disclosed therein are more widespread than described by applicant. In addition to those uses cited by applicant, we note reference to uses in "engineering, business, marketing and distribution."

Finally, as noted by the Examining Attorney, certain of the NEXIS excerpts of record also show reference to the use of GIS and GIS consulting services in connection with various types of industries.

All in all, we find the evidence sufficient to demonstrate that GIS and GIS consulting services may be used industry-wide. As such, applicant's proposed mark G.I.S., when used in connection with its consulting services which in fact employ geographic information systems, would be merely descriptive. The initialism

G.I.S. as used by applicant in connection with its consultation services, namely, providing geographic information systems for assisting distributors in locating and identifying potential customers for chains and sprockets would immediately convey information as to a significant feature of these consulting services, namely, the means actually employed in assisting distributors in locating potential customers. The evidence establishes that the initialism is as equally descriptive as the words "geographic information systems" themselves.

Decision: The refusal to register under Section 2(e)(1) is affirmed. The requirement for an acceptable identification of services is also affirmed.

**Ser No.** 75/103,066